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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,082	11/05/1999	KEVIN J. RYAN	303.306US2	3448

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EXAMINER
PEIKARI, BEHZAD

ART UNIT	PAPER NUMBER
2186	12

DATE MAILED: 03/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/434,082	Ryan
Examiner	**Art Unit**
B. James Peikari	2186

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jan 17, 2002

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 5-8 and 29-71 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 5-8 and 29-71 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 11/5/99 is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a data in buffer, a data out buffer, a column decoder, and a row decoder must be shown for each memory device (i.e., DRAM) or the feature(s) canceled from the claim(s). No new matter should be entered.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign mentioned in the description: data bus 120. Correction is required.

Specification

3. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

With regard to the paragraph beginning at page 8, line 3, upon further inspection, it appears that this should read "memory system 100 has eight memory subsystems, each with eight memory devices 135 (i.e., N times M equals sixty-four)".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5-8 and 29-71 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no mention in the specification of several critical features of the claims, specifically, that "each memory device contains a data in and a data out buffer, a column decoder and a row decoder".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5-8 and 29-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katayama et al., U.S. 5,875,452.

Katayama et al. teach the claimed invention in a memory system (*note especially Figure 9*) comprising:

a memory controller (*note memory controller 17, via controller 70*) with a unidirectional command and address bus (*note that the address and control lines from controller 70 to the decoders are all unidirectional*),

a bidirectional data bus (*note that data line 56 is bidirectional*), a plurality of memory devices, such as eight, (*note the use of up to sixteen exemplary DRAM devices 22*),

a shared command buffer (*note the registers A and B in controller 70, which are connected to each of the plurality of memory devices 22, as explained in column 26, lines 56-57*) coupled between the command and address bus (*18; note that bus 18 comprises, in part, a control bus and an address bus*) and the plurality of memory devices (*22*) for receiving and latching commands and addresses, and

a shared data buffer (*note data buffer 78*) connected between the plurality of memory devices (*22*) and the bidirectional data bus (*18; note that bus 18 comprises, in part, a data bus*) for receiving and latching read data or write data.

As for the claimed pipelined packet protocol, note column 2, lines 34 et seq. and column 20, line 6. [As to the meaning of "pipelined subsystems", it is clear from applicant's specification,

page 8, lines 27-30, that this means that each subsystem 130 is pipelined within itself. It does *not* mean that each subsystem is one link in a larger pipeline.]

As for the feature of each memory device containing a column decoder and a row decoder, note column 26, lines 51-57.

As for the feature of each memory device containing a data in buffer and a data out buffer, such was not specifically mentioned in the Katayama et al. system. However the benefits of adding additional levels of buffer hierarchies was well known at the time of the invention. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include data in and data out buffers for each of the memory devices 22 in the Katayama et al. system, since these buffers would have made the timing of the transfer operations to and from the shared buffers more efficient (by latching the data, control or address bits so that such protocols as time sharing could be utilized), especially considering the highly parallel nature of the Figure 9 embodiment of the Katayama et al. system.

At this point it is apparent that storage device 16 of Katayama et al. teaches (or suggests, in the case of the data in buffer and data out buffer) each and all of the features of *one* of applicant's memory subsystems 130.N. On the other hand, each of applicant's embodiments include a *plurality* of such memory subsystems. In the remarks submitted with the amendment filed January 17, 2002, applicant has now clarified the scope of what is meant by "memory subsystem" (when the specification mentions "each memory subsystem 130" it does *not* mean all of the units which start with "130", it really means "each memory subsystem 130.N", i.e. each *one*

of the units surrounded by dashed lines). Katayama et al. do not specifically mention that memory controller 17 could be connected to *more than one* storage device 16. However, the benefits of adding extra memory were quite well known. Whether extra memory devices 16 were added in parallel, series or in some combinations thereof, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add such extra devices since (1) extra memory meant that more data could be stored, (2) several storage devices 16 linked in parallel would have allowed for faster data retrieval via parallel data transfers, and (3) it was noted in St. Regis Paper Co. v Bemis Co. 193 USPQ 8 (7th Cir. 1977) that to duplicate parts for multiple effects is *not* given patentable weight.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 5-8 and 29-71 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 26-28 and 32-57 of copending Application No. 08/886,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because each and all of the features of the present claims are included in the claims of the '753 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Although the present application is a divisional of the '753 application, and the divisional resulted from a restriction requirement,

(1) the examiner concedes that claims 26-28 should have been included in group II, as opposed to group I. However,

(2) it is noted that *after* the restriction requirement was made, applicant never amended the claims 26-28 to be consonant with the restriction requirement;

quite the contrary,

(3) applicant added *more* claims directed to pipelining to the '753 *and*

(4) added several claims (specifically 38-43) to the present application which do not even mention pipelining at all.

Thus, both applications have been amended such that there is no longer any patentable distinction between the two sets of claims. Thus, a provisional obviousness-type double patenting rejection is deemed proper.

The following are situations where the prohibition of double patenting rejections under 35 U.S.C. 121 does not apply: .....

(b) The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner, since the claims have been changed in material respects from the claims at the time the requirement was made. For example, the divisional application filed includes additional claims not consonant in scope to the original claims subject to restriction in the parent. Symbol Technologies, Inc. v. Opticon, Inc. , 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991); Gerber Garment Technology, Inc. v . Lectra Systems Inc. , 916 F.2d 683, 16 USPQ2d 1436 (Fed. Cir. 1990).
Response to Amendment

Response to Amendment

10. With regard to the remarks submitted with the amendment filed January 17, 2002, these have been carefully considered but are not deemed convincing for at least the following reasons:

(A) With regard to the comments concerning the double patenting rejection, while applicant is allowed to wait to *file* the terminal disclaimer, waiting for *allowance* of the present claims to consider whether to file a terminal disclaimer is not appropriate since applicant will not receive any notice of allowance until applicant has either

(1) submitted arguments which convince the examiner that the double patenting rejection is not proper, or

(2) applicant has filed a suitable terminal disclaimer.

In any case, any arguments directed to the double patenting rejection should have been submitted with the amendment filed January 17, 2002.

(B) With regard to applicant's traversal of the rejection under 35 USC § 112, first paragraph, the missing subject matter from the specification cannot be incorporated by reference to a publication by another in 2001. Further, submitting two figures from *DRAM Circuit Design* are insufficient evidence to prove that this was the same DRAM that applicant used in his invention in 1997.

Applicant's comments are especially puzzling since, on page 5 of the *same* paper, applicant has challenged the examiner's statement that it would have been obvious to include data in and data out buffers for each of the DRAM memory devices 22 of Katayama et al.

(C) With regard to the comments in the final two lines of page 3 of the amendment, the examiner is inclined to agree. Later in the same remarks applicant defines exactly what is meant by each of "a memory device" and "a memory subsystem" and "a memory system". Although Katayama et al. does not teach a plurality of memory subsystems as defined by applicant, to include a plurality would have been obvious for the reasons described above.

(D) With regard to the first full paragraph on page 4 of the amendment, applicant's arguments are confusing, since the rejection mentioned where *each and every one* of the claimed elements could be found in Katayama et al.

(E) With regard to the next two paragraphs on page 4 of the amendment, the examiner absolutely disagrees that the words "packet" and "pipeline" are being used by Katayama et al. and by applicant to mean two different things. As stated by applicant "Katayama discusses the pipelined manner in reference to how the processing is carried out when a data read is requested

within the DRAM", however that "pipelined manner" *means* "overlapping operations by moving data or instructions into a conceptual pipe with all states of the pipe processing simultaneously", as defined by applicant. The two explanations are complementary, not contradictory. Further, if applicant's pipelining works in some other manner than this, then applicant is required to provide evidence of such in the specification.

(F) With regard to page 5 of the amendment, applicant suggests that the obviousness of one having ordinary skill in the art at the time the invention was made to include data in and data out buffers for each of the DRAM memory devices 22 in the Katayama et al. system could have only been possible with hindsight. The examiner submits that this is not hindsight. Rather, it was fundamental data processing technology. The advantages of buffers were notoriously well known at the time of the invention.

Applicant states that "stated motivation for modifying Katayama is one contained in the present disclosure", but fails to show where in the disclosure this statement appears. Further, applicant fails to dispute the well known advantages of buffering.

(G) As to the last full paragraph on page 5, the examiner would like to know exactly *which* elements Applicant thinks are missing from the rejection. No Official notice was taken, and none was needed. Each element of the claims was either taught or suggested by the Katayama et al. reference alone.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Peikari whose telephone number is (703) 305-3824.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached at (703) 305-3821.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 746-7239 (Official communications)

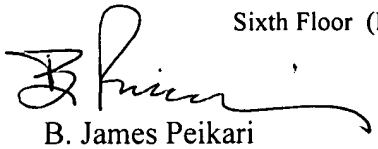
or:

(703) 746-7240 (for Informal or Draft communications)

or:

(703) 746-7238 (for After-Final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).



B. James Peikari
Primary Examiner
Art Unit 2186

March 12, 2002